

The opinion in support of the decision being entered today is  
*not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL D. GILBERT

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Appeal 2007-3550  
Application 09/352,976  
Technology Center 1700

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Decided: September 6, 2007

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Before BRADLEY R. GARRIS, THOMAS A. WALTZ,  
and JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1, 4-6, 8, 9, 14-26, 28-30, 32, and 66-80. We have jurisdiction under 35 U.S.C. § 6(b). Claim 1 is illustrative of the subject matter on appeal:

1. An electrochemically disbondable composition, comprising:  
a polymer; and

an electrolyte, wherein the electrolyte provides sufficient ionic conductivity to said composition to enable a faradaic reaction at a bond formed between the composition and an electrically conductive surface and allow the composition to disbond from said surface.

The Examiner relies on the following prior art references to show unpatentability:

Moulton	US 5,441,830	Aug. 15, 1995
Koga	US 5,565,284	Oct. 15, 1996

The invention relates to an electrochemically disbondable composition comprising a polymer and an electrolyte. The composition is said to exhibit sufficient ionic conductivity to enable a faradaic reaction at a bond formed between the composition and an electrically conductive surface, thereby allowing the composition to disbond from the surface (Specification 3).

The rejections as presented by the Examiner are as follows:

Claims 1, 5, 6, 8, 9, 14-22, 25, 26, 28, 29, and 68-80 are rejected under 35 U.S.C. § 102(b) as anticipated-by Moulton as evidenced by Koga<sup>1</sup>; and claims 4, 23, 24, 30, 32, 66, and 67 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Moulton evidenced by Koga.

Implicit in our review of the Examiner's anticipation and obviousness analysis is that the claim must first have been correctly construed to define

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<sup>1</sup> Claim 26 was inadvertently excluded from the statement of rejection. However, the subject matter of claim 26 was included in the Examiner's discussion of the stated rejection.

the scope and meaning of each contested limitation. *See Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). During prosecution before the Examiner, the claim language should be given its broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account any definitions or enlightenment contained in the written description of Appellant's Specification. *See In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). "[T]he specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.'" *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315, 75 USPQ2d 1321, 1327 (Fed. Cir. 2005) (en banc).

Applying the preceding legal principles, we determine that the claims on appeal are directed to an electrochemically disbondable composition, comprising a polymer and an electrolyte that provide ionic conductivity sufficient to enable a faradaic reaction.

A claimed invention is anticipated under 35 U.S.C. § 102 when all of the elements of the claimed invention are found in one reference. *See Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). The prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1433 (Fed. Cir. 1997).

The issue presented for review with respect to this rejection is: Does the Moulton reference have a disclosure that anticipates the claimed subject matter? The issue turns on whether Moulton describes an electrochemically

disbondable composition, comprising a polymer and an electrolyte that provides ionic conductivity sufficient to enable a faradaic reaction. We answer this question in the negative.

The Examiner asserts that Moulton describes an electrochemically disbondable composition comprising a polymer and an electrolyte that provides ionic conductivity. The Examiner recognizes that Moulton does not describe that a faradaic reaction weakens the adhesion between the composite electrode and the current collector foil. The Examiner asserts that in the absence of an adhesion promoter the composition of Moulton has the same structure as the claimed invention (Answer 3-4). The Examiner cites the Koga reference for describing “that when an electrode is formed on a current collector typically in the form of a metal foil, repetition of charge-discharge cycles exacerbates (weakens) the interfacial adhesion (bonding) between the current collector and the electrode, caused by the expansion and contraction during doping and dedoping of the active material upon charging and discharging” (Answer 4). The Examiner asserts that this description of Koga establishes that a faradaic reaction weakens the adhesion between the composite electrode and the current collector foil.

We agree with the Appellant that the Examiner has failed to establish that the claimed invention is expressly or inherently described by Moulton as evidenced by Koga (Br. 6-7). Moulton describes composite electrodes for electrochemical reactions to generate current. We also agree with Appellant that Koga’s description of problems with the electrode layers does not support the Examiner’s position (Br. 9). Koga attributes bond weakening to mechanical effects and to general binder decomposition due to the repetition of charging and discharging (Koga, col. 1, ll. 48-60). As such, the Examiner

has failed to establish that the cited references establish that a faradaic reaction is the cause of the weakening of the adhesion between the composite electrode and the current collector foil.

For the foregoing reasons and those stated in the Briefs, we determine that the Examiner's conclusion of anticipation and obviousness is not supported by facts on the present record. Accordingly, the Examiner's rejection of claims 1, 4-6, 8, 9, 14-26, 28-30, 32, and 66-80 is reversed.

REVERSED

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GOODWIN PROCTER LLP  
PATENT ADMINISTRATOR  
EXCHANGE PLACE  
BOSTON MA 02109-2881